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**Commissioner for Patents** P.O. Box 1450 Alexandra, VA 22313-1450 on March 4, 2004

**Date of Deposit** 

James P. Naughton, Reg. No. 30,665

Name of Applicant, Assignee or Registered Representative

Signature

March 4, 2004

**Date of Signature** 

MAR 1 0 2004

**GROUP 3600** 

Our Case No.: 9623/656

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

William Gross

Serial No.: 09/765,270

Filing Date: January 18, 2001

SYSTEM AND METHOD FOR

RANKING ITEMS

Examiner: James S. McClellan

Group Art Unit: 3627

## INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir:

In compliance with the duty of disclosure under 37 C.F.R. § 1.56, it is respectfully requested that this Information Disclosure Statement be entered and the documents listed below and on the attached Form PTO-1449 be considered by the Examiner and made of record.

03/09/2004 SSANDARA 00000021 09765270

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The references now cited are the following:

## **U.S. PATENT DOCUMENTS**

DOCUMENT	<u> </u>	
NUMBER	DATE	NAME
Number-Kind Code (if known)	00/40/07	12'
5,659,732	08/19/97	Kirsch
5,664,115	09/02/97	Fraser
5,704,060	12/30/97	Del Monte
5,717,923	02/10/98	Dedrick
5,724,424	03/03/98	Gifford
5,724,521	03/03/98	Dedrick
5,724,524	03/03/98	Hunt et al.
5,748,954	05/05/98	Maudlin
5,752,238	05/12/98	Dedrick
5,768,521	06/16/98	Dedrick
5,778,367	07/07/98	Wesinger et al.
5,794,210	08/11/98	Goldhaber, et al.
5,826,241	10/20/98	Stein, et al.
5,848,397	12/08/98	Marsh, et al.
5,848,407	12/08/98	Ishikawa, et al.
5,852,820	12/22/98	Burrows
5,855,008	12/29/98	Goldhaber, et al.
5,862,223	01/19/99	Walker et al.
5,864,845	01/26/99	Voorhees, et al.
5,864,846	01/26/99	Voorhees, et al.
5,903,882	05/1999	Asay et al.
5,918,014	06/29/99	Robinson
5,920,854	07/06/99	Kirsch, et al.
5,920,859	07/06/99	Li
5,930,777	07/27/99	Barber
5,945,975	08/31/99	Lundrigan et al.
6,078,866	06/2000	Buck et al.
6,078,916	06/20/00	Culliss
6,128,599	10/03/00	Walker et al.
US 6,185,558 B1	02/06/01	Bowman et al.
US 6,269,361 B1	07/31/01	Davis et al.
US 2001/0014868 A1	08/16/01	Herz et al.
US 6,278,966 B1	08/21/01	Howard et al.
US 6,285,987 B1	09/04/01	Roth et al.
US 6,286,005 B1	09/04/01	Cannon
US 6,311,185 B1	10/30/01	Markowitz et al.
US 6,366,918 B1	04/02/02	Guttman et al.
US 6,411,936 B1	06/25/02	Sanders
US 6,470,269 B1	10/22/02	Adar et al.
US 6,487,538 B1	11/26/02	Gupta et al.
US 6,594,641 B1	07/15/03	Southam
US 2003-0149937 A	08/07/03	McElfresh et al.
US 2003-0149938 A	08/07/03	McElfresh et al.

## FOREIGN PATENT DOUMENTS

DOCUMENT NUMBER	DATE	COUNTRY
JP 11316765 A	11/1999	JAPAN
WO 99/20486	09/1999	WIPO
WO 99/48028	09/1999	WIPO
WO 2000/16218	03/2000	WIPO
WO 2000/41090	07/2000	WIPO

## OTHER ART AND RELATED DOCUMENTS

Espe, "Online Search Engines Start To Charge For Listings", Washington Business Journal, Vol. 18, Issue 1, May 1999, printed from the Internet at:

<wysiwyg://bodyframe.3/http://ehost...22%20and %20search%2a%20&fuzzyTerm=>, 3 pages.

Dawson et al., "2 Search Sites Narrow Their Parameters", Adweek-Western Edition, Vol. 48, Issue 42, Oct. 1998, printed from the Internet at:

<wysiwyg://bodyframe.3.http://ehost...22%20and%20search%2a%20&fuzzyTerm=>, 2 pages.

Database of Corporate ResourceNet, "Bits", from Adweek-Eastern Edition, Vol. 40, Issue 14, April 1999, printed from the Internet at:

<wysiwyg://bodyframe.3.http://ehost...22%20and%20search%2a%20&fuzzyTerm=>, 2 pages.

Komando, "Searching For Search Engines - from Dogpile to Deja News", Business First-Colombus, Vol. 14, Issue 43, June 1998, printed from the Internet at:

<wysiwyg://bodyframe.3.http://ehost...22%20and%20search%2a%20&fuzzyTerm=>, 2 pages.

Database of Corporate ResourceNet, "Goto.com Chooses Quest's SharePlex(R) for Oracle Software to Ensure Uptime for Business-Critical Web Site", PR Newswire, June 2000, printed from the Internet at: <a href="https://ehost...anTerm=%22GOTO%2eCOM%22&fuzzyTerm=">wysiwyg://bodyframe.3.http://ehost...anTerm=%22GOTO%2eCOM%22&fuzzyTerm=</a>, 2 pages.

Database of Corporate ResourceNet, "Capitalist Tool", Time Canada, Vol. 151, Issue 8. March 1998, printed from the Internet at:

<a href="http://time.qpass.com/time/magazine/article/qpass/item.0,10987,,00html?QProd-1&QIID=1...,1 page.">http://time.qpass.com/time/magazine/article/qpass/item.0,10987,,00html?QProd-1&QIID=1...,1 page.</a>
Database of DialogClassic(m), :Homestead Technologies' Continued Success Draws \$17.50 Million In second Round of Venture Funding", PR Newswire, April 1999, 2 pages

"APS Search Tools - Patent Search Client Strategy", by US Patent & Trademark Office, Sept. 199, 5 pages.

"Frequently Asked Questions NT Image Search & Retrieval (IS&R)", by US Patent & Trademark Office, Dec. 1997, 20 pages.

"Chapter 1-Introduction to Dialog", by Dialog Information Service, Inc. pp 1-1 to 1-14.

"Automated Patent System (APS) Workstation Reference Manual", by US Patent & Trademark Office, July 1996. 3 pages.

Frentzen, Jeff, "Help for Getting the Word Out About Web Sites", PC Week, Vol. 14, No. 46, Nov. 3, 1997, 3 pages.

Miller, Karen L., "Improve Your Ranking (Building Web Sites to Attract Web Searches)", Home Office Computer, Vol.16, No.1, Jan. 1998, 3 pages.

Wingfiled, Nick, "Another Engine Takes Ads By The Click", printed from the Internet at: http://www.news.com/News/Item/0.4.1387,00/html, May 1996, 3 pages.

Pelline, Jeff "New Search Engine Goes Commercial", by CNET News.com, printed from the Internet at: http://www.news.com/News/Item/0.4.19281,00/html, Feb. 1998, 2 pages.

Wang, Nelson "Engines Battle Irrelevance of Results-New Search Service Hope To Fill The Void", by Internet World, printed from the Internet at: http://www.internetworld.com/print/current/news/19980223-battle.html, Feb. 1998, 2 pages.

Vondr Haar, Steven "Searching For The Highest Bidder", from Inter@active week, printed from the Internet at: http://www.zdnet.com/intweek/daily.980219i.html, Feb. 1998, 2 pages.

Riedman, Patricia "Search Engine Startup To Auction Listings", from Interactive-Advertising, Feb. 1998, 1 page.

Rich, Laura "New Search Engine Allows Sites To Pay Their Way to Top", printed form the Inter at: http://www.adweek.com/iq/iqnews02.asp, Feb. 1998, 1 page.

Mardesich, Jodi "Web Site Operators Pay for Top Billing-Search Engine Allows Site Sponsors to Buy Place On Special List", from Knight Ridder Newspapers, March 1998, 2 pages.

Hilty, Wyn "GoTo.Hell-What Happens When On Line Search Engine Accepts Cash From Web Sites?" printed from the Internet at: http://www.ocweekly.com/link/archives/97/27/byte-3.11.98-1.html, March 1998, 3 pages.

Flynn, Laurie "With GoTo.com's Search Engine, the Highest Bidder Shall Be Ranked First", by the New York Times, March 1998, 1 page.

Clark, Don "Start-Up Plans Internet Search Service Tying Results To Advertising Spending", from the Wall Street Journal, Feb. 1998, 1 page.

"Going, Going ...", from A Closer Look of the Wall Street Journal-Marketplace, April 1998, 1 page.

"Coursey.com", David Coursey's Insider report on Personal Computing, the Internet and Communications", March 1998, 2 pages.

Glaser, Ken "Who Will GoTo.com", from OnlinePress.com, printed from the Internet, Feb. 1998, 2 pages.

Mardesic, Jodi "Search Engine Charges Hit Sites", printed from the Internet at:

http://www.sjmercury.com/business/center/goti022198.html, Feb. 1998, 2 pages.

"News Watch About Search Engines", printed form the Internet at:

http://searchenginewatch.com/ness.html, Feb. 1998, 2 pages.

Wang, Nelson "Engines Battle Irrelevance of Results", from Internet World, Feb. 1998, 4 pages.

Swartz, Jon "Browser Only Lists Paying Web Sites Critics Fear Approach Will Squeeze Out Most Small Internet Players", publish on San Francisco Chronicle, Feb. 1998,

printed from the Internet at: http://www.sfgate.com/cgi-

bin/article.cgi?file=/chronicle/archive/1998/02/21/BU102470.DTL, 3 pages.

McWilliams, Brian "Search Engine To Sell Top Positions On Results Lists", PC World Online, February 23, 1998, printed from the Internet at: http://www.pcworld.com/news/daily/data/ 0298/....html, 1 page .

Riedman, Patricia "Search Engine Start Up To Auction Listings", Advertising Age, Feb. 1998, 1 page.

Alyson, Sasha "Searching The Search Engines", Bacon's, May 1998, 1 page.

Pelline, Jeff "Pay-for-placement gets another shot", printed from the Internet at:

http://www.newscom./news/item/0,4,19307,00.html, Sept. 1997.

IBM Technical Disclosure Bulletin, "Organizing A Ranked List of Search Matches", Nov. 1994, printed form the Internet at: http://westbrs:8820/bin/gate.exe?f...PTFFull&p-doc-3=&p-doc-4=, 2 pages.

Brewer, Jeffrey "Pay-For-Performance: Creating More And Better Value", ClickZ Today, August 18, 1998, printed from the Internet at: wysiwyg://37/http://www.clickz.com, 5 pages.

Berst, Jesse ZDNet, "Search Sites' Shocking Secret", August 17, 1998, printed form the internet at: http://www.zdnet.com/anchordesk/story/story\_2432.html, 2 pages.

Fisher, Sara "Budding Internet Firm Finds Niche in Satisfaction", L.A. Business Journal, August 10, 1998, 1 page.

"Disclosure Rules", The Industry Standard – The Newsmagazine of the Internet Economy, August 10, 1998, 1 page.

G. David Doran, "Pay to Play", Entrepreneur, July 1998, 1 page.

Advertising Age-Interactive Daily Homepage; June 8, 1998, printed from the Internet at: http://www.adage.com/interactive/daily/index.html, 2 pages.

Komando, Kim "With About 320 Million Sites, Search Engines Offer Some Help", copyright 1998, Los Angeles Times Syndication, 1 page.

Margot Williams, "How To Ease Your Online Searches", Lansing State Journal, June 1, 1998, 1 page.

"GoTo.com Gets Venture Funding", Internet World Magazine, June 1, 1998, 1 page .

Sasha Alyson, "Searching The Search Engines", Front Page, May 8, 1998, 1 page.

Advertising Age-Interactive Daily Homepage, February 23, 1998, "Search Engine Startup To Auction Listings", printed from the Internet address http://www.adage.com/interactive/ mdaily/index.html, 2 pages.

McWilliams, Brian PC World Online, February 23, 1998, "Search Engine To Sell Top Positions On Results Lists", printed from the Internet address http://www.pcworld.com/news/daily/data/0298/9880223173204.html, Feb. 1998, 1 page.

Swartz, Jon - San Francisco Chronicle, February 23, 1998, "Browser Only Lists Paying Web Sites Critics Fear Approach Will Squeeze Out Most Small Internet Players", printed from the Internet address http://www.sfgate.com/cgi-bin/arti...le/archive/1998/02/21/BU102470.DTL, Fe, 1998, 1 page.

Wang, Nelson "Engines Battle Irrelevance of Results", printed from the Internet at" http://www.internetworld,com/print/current/news/19980223-battle.html, Feb. 1998, 3 pages.

Search Engine Watch, February 21, 1998, "GoTo Sells Positions", printed from the Internet address http://www.searchenginewatch.com/news.html, February 23, 1998, 2 pages.

Mardesich, Jodi "Search Engine Charges Hit Sites", from

http://www.sjmercury.com/businrss/center/goto022198.html, Feb. 1998.

Glaser, Ken "Who Will GoTo.com?", OnlinePress.com, Feb. 1998, 2 pages.

Pelline, Jeff "New Search Engine Goes Commercial", printed from the Internet at:

http://www.news.com/News/Item/ 0,4,19281,00.html, February 20, 1998, 2 pages.

"Going, Going...", The Wall Street Journal, Marketplace, April 1998, 1 page.

Coursey, David "Coursey.com", March 1998, 2 pages.

Clark, Don "Start-Up Plans Internet Search Service Tying Results To Advertising Spending", The Wall Street Journal, Marketplace February 20, 1998, 1 page.

Flynn, Laurie J. "With GoTo.com's Search Engine, The Highest Bidder Shall Be Ranked First", The New York Times, Business Day, March 1998, 1 page.

Hilty, Wyn OCWeekly byte marks, "GoTo. Hell", printed from the Internet at:

http://www.ocweekly.com/ink/archives/97/27byte-3.11.98-1.shtml, March 13, 1998, 3 pages.

Mardesich, Jodi "Web Site Operators Pay For Top Billing", The News – Herald (Willoughby, OH), March 2, 1998, 2 pages.

Rich,Laura Adweek Online IQ News Online, February 23, 1998, "New Search Engine Allows Sites to Pay Their Way to Top", printed from the Internet at: http://www.adweek.com/iq/ iqnews02.asp, Feb. 1998. 1 page.

Riedman, Patricia "Search Engine Startup To Auction Listings", Advertising Age Magazine, February 23, 1998. 1 page.

Vonder Haar, Steven ZDNet,com, Inter@ctive Week February 19, 1998, "Searching For The Highest Bidder", printed from the Internet at: http://www.zdnet.com/intweek/daily/980219i.html, February 23, 1998, 2 pages.

Wang, Nelson "Engines Battle Irrelevance of Results", Internet World, Feb. 10, 1998, printed from the Internet at: http://www.internetworld.com/print/current/news/19980223-battle.html, 3 pages.

Interactive Week Magazine, Garden City, N.Y. May 25, 1998, 1 page.

Pelline, Jeff "New Search Engine Goes Commercial", CNET News.com, printed from the Internet at: http://www.news.com/News/Item/0,4,19281,00.html, Feb. 20, 1998, 2 pages.

Wingfield, Nick CNET News.com, June 21, 1996, "Engine Sells Results, Draws Fire", printed from the Internet at: http://www.news.com/News/Item/Textonly/0,25,1635,00. html, July 29, 1999, 2 pages.

Wingfield, Nick CNET News.com, May 22, 1996, "Another Engine Takes Ads By The Click", printed from the Internet at: http://www.news.com/News/Item/0,4,1387,00.html, July 29, 1999, 2 pages.

Aguilar, Rose CNET News.com, April 29, 1996, "New Ad Model Charges By The Click", printed from the Internet at: http://www.news.com/News/Item/0,4,1199,00.html, July 29, 1999, 3 pages.

Lash, Alex CNET News.com, December 11, 1996, "Open Text Updates Tools", printed from the Internet at: http://www.news.com/News/Item/0,4,6118,00.html, July 29, 1999, 3 pages.

"About SearchUP, Inc.", July 15, 1999, printed from the Internet at: http://www.searchup.com/about.cfm, 2 pages.

"Testimonials", July 15, 1999, printed from the Internet at: http://www.searchup.com/testimonials.cfm, 2 pages.

"Benefits", July 15, 1999, printed from the Internet at: http://www.searchup.com/benefits.cfm, 3 pages. "Information", July 15, 1999, printed from the Internet at: http://www.searchup.com/information.cfm, 4 pages.

"Tips & Tricks", July 15, 1999, printed from the Internet at:

http://www.searchup.com/tipsandtricks.cfm, 4 pages.

Correspondence from Bryan Buck, President of SearchUp.com, dated July 7, 1999, 1 page.

Hansell, Saul "Alta Vista Invites Advertisers to Pay for Top Ranking", The New York Times, April 15, 1999, 1 page.

Galore - Super Search Engine, May 21, 1999, printed from the Internet at:

http://www.galore.com/1/mainframe.shtml, 7 pages.

hitsgalore.com Search Engine, May 21, 1999, printed from the Internet at:

http://www.hitsgalore.com. 8 pages.

I Seek It "The Next Generation Search Engine", May 21, 1999, printed from the Internet at: http://www.iseekit.com, 6 pages.

Correspondence from Emilia F. Cannella to Robert Brahms, CEO of BeFirst Internet Corporation regarding findwhat.com, July 20, 1999, 2 pages.

Correspondence from Emilia F. Cannella to Michael Melcher, MC Services regarding SearchUP.com, July 1, 1999, 3 pages.

Correspondence from Emilia F. Cannella to Robert G. Schuler, Esq., Kegler, Brown, Hill & Ritter regarding iseekit.com, July 1, 1999, 2 pages.

Correspondence from Emilia F. Cannella to Andrew Conru, Vote Publishing regarding galore.com, June 30, 1999, 2 pages.

SearchUP.com – Internet Directory, Automated Bid Placement System, printed from the Internet at: http://www.searchup.com/search.cfm, August 25, 1999, 3 pages.

SearchUP: URL Position Manager, printed from the Internet at:

https://www.securearea.net/searchup/login.cfm, August 25, 1999, 1 page.

SearchUP: URL Position Manager, printed from the Internet at:

https://www.securearea.net/searchup/newaccount.cfm, August 25, 1999, 4 pages.

SearchUP: URL Position Manager, printed from the Internet at:

https://www.securearea.net/searchup/addurl.cfm, August 25, 1999, 5 pages.

Correspondence from Emilia F. Cannella to Mr. D. Reed, Reports Galore, regarding hitsgalore.com, June 30, 1999, 2 pages .

Miller, Karen L., "Improve Your Ranking", Home Office Computer, Vol. 16, No. 1, Jan. 1998, p. 51(2), 3 pages.

Fretzen, Jeff "Help For Getting The Word Out About Web Sites", PC Week, Vo. 14, No. 46, Nov. 3, 1997, p. 27(1), 3 pages.

Article from the Search Engine Report, "GoTo To Sell Positions", March 3, 1998, printed from the Internet at: http://www.searchenginewatch.com/sereport/9803-to-to-html, 1 page.

Wingfield, Nick "Engine Sells Results, Draws Fire", June 21, 1996,

http://www.nees.com/News/Item/0,4,1635,00.html, 2 pages.

Press release,"Netscape Announces Netscape Directory Server To Deliver Open, Cross-Platform LDAP-Based Directory Services For Locating Online Users and Resources," April 1996, printed from the Internet at: http://home.netscape.com/newsref/pr/newsrelease126.html. 3 pages.

ClickMail Central directory, printed from the Internet at: http://www.oneclaick.com/server/specs.html, circa April 1996, 4 pages.

GoTo.com, circa 1998, printed from the Internet at: www.goto.com/d/search-results/html, Aug. 1998 5 pages.

Northern Light, printed from the Internet at: www.sirocco.northernlight.com, June 1998, 11 pages.

Rich, Laura Adweek Online IQ News Online, February 23, 1998, "New Search Engine Allows Sites to Pay Their Way to Top", printed from the Internet at:

http://www.adweek.com/ig/ iqnews02.asp, February 23, 1998, 1 page.

Smith, Laura B., article "Going ... Gone", PC Week, Vol. 13, No. 34, dated August 26, 1996, p E1 (2), printed from the Internet at: http://www.dialog-classic.com/DialogClassic/dialog, 4 pages.

Cliff Kurtzman, "Another Internet Advertising List", Internet Advertising Digest #006, dated June 19, 1996, printed from the Internet at: http://www.o-a.com/archive/1996/june.0021.html, printed 09/28/01, 5 pages.

Press Release article titled "GoTo.com Announces First round of Financing, Totaling More Than \$6 Million, Led by Draper, Fisher Jurvetson", *Business Wire*, dated May 19, 1998, printed from the Internet at http://www.dialogclassic.com/main.vingw, 2 pages.

News of The Week articles, Telephony, May 1, 1995, pages 8 and 10.

Nuts 'N Bolts articles, Target Marketing, October 1997, 1 page.

DoubleClick TestIt!, obtained at the internet address:

http://web.archive.org/web/19980205034316/www.doubleclick.com/nf/adinfo/testiset.htm, dated 10/16/2002, 4 pages.

DoubleClick Frequently Asked Questions, obtained at the internet address:

http://web.archive.org/web/19980205033925/www.doubleclick.com/nf/adinfo/facts.htm, dated 10/16/2002, 5 pages.

"New Service Puts Ad Auction, Search Engine Under One Roof', article from Electronic Advertising & Marketplace Report, Simba Information, Inc. April 28, 1998, 2 pages.

Google Search, communication from Jeffrey Brewer at Jeffrey@goto.com, titled "Need reverse stemming software", dated May 27, 1998, obtained at the internet address:

http://groups.google.com/groups?selm=356CEE4A8DE882A8%40goto.com, on 12/19/02, 1 page.

Ketchpel, Steven P. et al. "U-PAI: A Universal Payment Application Interface", conference material article from the Second USENIX Workshop on Electronic Commerce Proceedings", Oakland, California, November 18-21, 1996, 17 pages.

Schwartz, Randal L., "Click-Through Tracking in Perl", Web Techniques, dated May 1998, located at the internet address: www.webtechniques.com, 3 pages.

Van Roeden, Adriaan, "Your Own Search Engine With SWISH, A Custom Search Facility For Your Web Site", *Web Techniques*, dated November 1996, located at the internet address: www.webtechniques.com, pp. 63-66 pages.

Full Catalog – Categories Menu, Sun Microsystems Sun Solutions Catalog, obtained at the internet address: http://web.archive.org/web/19981205110211/solutions.sun.com/catalogs/all/index.htm, on 12/19/02, 2 pages.

Help on Making Queries – Search by Company or Product, obtained at the internet address: http://web.archive.org/web/19981203050002/solutions.sun.com/search-help.htm, printed on 12/19/02, 4 pages.

Online Updating, Sun Microsystems Sun Solutions Catalog obtained at the internet address: http://web.archive.org/web/19990220190636/solutions.sun.com/editmodule/help.html, printed on 12/19/02, 2 pages.

Ebay – Your Personal Trading Community, Seller Service Listings, dated April 28, 1999, printed from the Internet at: http://web.archive.org/web/19990428111841/www.ebay.com/,

19 pages

In accordance with 37 C.F.R. § 1.97(g),(h), this Information Disclosure Statement is not to be construed as a representation that a search has been made and is not to be construed to be an admission that the information cited is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

This Information Disclosure Statement is being filed after the receipt of the first Official Action reflecting an examination on the merits and hence applicants are enclosing herewith a check in the amount of \$180.00 for the prescribed fee. However, should any additional fees under 37 C.F.R. §§ 1.16 to 1.21 be deemed necessary for any reason relating to these materials, the Commissioner is hereby authorized to deduct said fees from Brinks Hofer Gilson & Lione Deposit Account No. 23-1925.

Applicant respectfully requests that the listed documents be made of record in the present case.

Respectfully submitted,

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